


# EXHIBIT C

<b>Interview Summary</b>	Application No. <b>09/791,301</b>	Applicant(s) <b>PAGRATIS et al.</b>	
	Examiner <b>S. Zitomer</b>	Art Unit <b>1634</b>	

All participants (applicant, applicant's representative, PTO personnel):

(1) S. Zitomer, Primary Examiner (3) \_\_\_\_\_

(2) Steven Hird, Applicant's Representative (4) \_\_\_\_\_

Date of Interview Nov 7, 2002

Type: a) ☒ Telephonic b) ☐ Video Conference  
c) ☐ Personal (copy is given to 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No. If yes, brief description:

Claim(s) discussed: N/A

Identification of prior art discussed:

N/A

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

Pursuant to the interview of August 30, 2002 between the above named parties, applicant was advised that on reconsideration examiner had determined that no nucleic acid ligand sequences would be searched in view of the findings in the Patent Office and in the office of applicant's representative that nucleic acid ligand sequences are not found among the coding sequences in the public databases. This determination applies to all of the nucleic acid ligand applications handled by this examiner. Pursuant to consultation with SPE Gary Jones, it is stated for the record that this determination applies only to applications handled by the above-named examiner.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☒ It is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

\_\_\_\_\_  
Examiner's signature, if required

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## DETAILED ACTION

### Informalities

1. The disclosure is objected to because of the following informalities: Words that are capitalized in original claims are not capitalized in the amended claims. Consistency is required for clarity. Appropriate correction is required.

### Rejection under 35 U.S.C. 112, second paragraph: Indefiniteness

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is confusing because the nucleotide designators, e.g., "mG", "rU", are not identified. A key identifying the designators is suggested.

### Double patenting obviousness type rejections

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,346,611. Although the conflicting claims are not identical, they are not patentably distinct from each other because patent claims 1-5 are drawn to RNA ligands to TGF $\beta$ 2 with (claims 2-5) and without (claim 1) complexation with a high molecular weight compound such as PEG and application claims 1-8 are drawn to RNA ligands to TGF $\beta$ 1. It would have been obvious to the skilled practitioner in the art to make nucleic acid ligands and complexes to both forms of TGF $\beta$  in view of their similar structures and functions. In addition, application claims 9-14 are generic over patent claims 2-5.

4. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,124,449. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are drawn to RNA ligands to TGF $\beta$ 1 and thus are obvious variants of one another.

**Conclusion**

5. **No claim is allowed.**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephanie Zitomer whose telephone number is (703) 308-3985. The examiner can normally be reached on Monday through Friday from 9:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152. The official fax phone number for this Group is (703) 308-4242. The unofficial fax number is (703) 308-8724. The examiner's Rightfax number is 703-746-3148.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Stephanie Zitomer, Ph.D.

November 18, 2002

**STEPHANIE W. ZITOMER**  
**PRIMARY EXAMINER**

**Notice of References Cited**Application/Control No.  
**09/791,301**Applicant(s)/Patent Under Reexam  
**PAGRATIS et al.**Examiner  
**S. Zitomer**Art Unit  
**1634**

Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number	Date	Name	Classification <sup>2</sup>	
		Country Code-Number-Kind Code	MM-YYYY <sup>1</sup>			
x	A	6,346,611	2/2002	Pagratiss et al.	536	23.1
x	B	6,124,449	9/2000	Gold et al.	536	23.1
	C					
	D					
	E					
	F					
	G					
	H					
	I					
	J					
	K					
	L					
	M					

**FOREIGN PATENT DOCUMENTS**

*		Document Number	Date	Country	Name	Classification <sup>2</sup>	
		Country Code-Number-Kind Code	MM-YYYY <sup>1</sup>				
	N						
	O						
	P						
	Q						
	R						
	S						
	T						

**NON-PATENT DOCUMENTS**

*	Include, as applicable: Author, Title, Date, Publisher, Edition or Volume, Pertinent Pages					
	U					
	V					
	W					
	X					

<sup>1</sup> A copy of this reference is not being furnished with this Office action. See MPEP § 707.05(a).<sup>1</sup> Dates in MM-YYYY format are publication dates.<sup>2</sup> Classifications may be U.S. or foreign.

FORM PTO-1449 U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE  LIST OF INFORMATION CITED BY APPLICANT Page 1 of 2	ATTY. DOCKET NO. NEX 87/C	SERIAL NO. 691791, 381
	APPLICANT PAGRATIS <i>et al.</i>	
	FILING DATE FEBRUARY 23, 2001	GROUP 1634

1017 U.S. PTO  
 09/791301  
 02/23/01

U.S. PATENT DOCUMENTS							
EXAM. INITIAL		DOCUMENT NUMBER	DATE	NAME	CLS	SUB- CLS	FILE DATE
<i>SE</i>	AA	5,723,323	03/03/98	Kauffman <i>et al.</i>			
	AB	5,731,424	03/24/98	Toothman <i>et al.</i>			
	AC	5,859,228	01/12/99	Janjic <i>et al.</i>			
	AD	6,011,020	01/04/00	Gold <i>et al.</i>			

FOREIGN PATENT DOCUMENTS							
EXAM. INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLS	SUB- CLS	TRANS?
<i>SE</i>	AE	WO 91/19813	12/26/91	PCT			
	AF	WO 92/14843	09/03/92	PCT			
	AG	WO 89/06694	07/27/89	PCT			
	AH	2 183 661 A	06/10/87	UK			

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)		
<i>SE</i>	AI	Joyce (1989) <i>Gene</i> <u>82</u> :83
	AJ	Joyce & Inoue (1989) <i>Nucleic Acids Research</i> <u>17</u> :711
	AK	Ellington & Szostak (1990) Abstracts of papers presented at the 1990 meeting on RNA Processing, Cold Spring Harbor Laboratory, Cold Spring Harbor, NY, p. 84
	AL	Kinzler & Vogelstein (1989) <i>Nucleic Acids Research</i> <u>17</u> :3645
	AM	Kramer <i>et al.</i> (1974) <i>J. Mol. Biol.</i> <u>89</u> :719
	AN	Levisohn & Spiegelman (1969) <i>Proc. Natl. Acad. Sci. USA</i> <u>63</u> :805
	AO	Levisohn & Spiegelman (1968) <i>Proc. Natl. Acad. Sci. USA</i> <u>60</u> :866
	AP	Oliphant <i>et al.</i> (1989) <i>Mol. Cell. Biol.</i> <u>9</u> :2944
	AQ	Oliphant & Struhl (1988) <i>Nucleic Acids Research</i> <u>16</u> :7673
EXAMINER	<i>S. Etomer</i> <div style="float: right;">DATE CONSIDERED <u>11-18-02</u></div>	
*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and <u>not</u> considered. Include copy of this form with next communication to applicant.		

FORM PTO-1449 U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE  LIST OF INFORMATION CITED BY APPLICANT  Page 2 of 2	ATTY. DOCKET NO. NEX 87/C	SERIAL NO.
	APPLICANT PAGRATIS <i>et al.</i>	
	FILING DATE FEBRUARY 23, 2001	GROUP

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)		
<del>157</del>	BA	Oliphant & Struhl (1987) Methods in Enzymology <u>155</u> :568
	BB	Oliphant et al. (1986) Gene <u>44</u> :177
	BC	Robertson & Joyce (1990) Nature <u>344</u> :467
	BD	Thiesen & Bach (1990) Nucleic Acids Research <u>18</u> :3203
	BE	Szostak, "Structure and Activity of Ribozymes," in <u>Redesigning the Molecules of Life</u> , (S.A. Benner ed.) Springer-Verlag Berline Heidelberg, pp. 87-113 (1988)
EXAMINER <i>S. J. Armer</i>		DATE CONSIDERED <i>11-18-02</i>
<small>* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and <u>not</u> considered. Include copy of this form with next communication to applicant.</small>		



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/791.301	02/23/2001	Nikos Pagratis	NEX 87/C	9270

7590 11/20/2002  
Swanson & Bratschun L.L.C.  
Suite 330  
1745 Shea Center Drive  
Highlands Ranch, CO 80129

EXAMINER

ZITOMER, STEPHANIE W

ART UNIT PAPER NUMBER

1634

DATE MAILED: 11/20/2002

25

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/791,301

Applicant(s)

PAGRATIS et al.

Examiner

S. Zitomer

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 3, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 10
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other: